LIBRARY
SUPREME COURT, U. S.

Supreme Court, U. S.
FILED
JUN 17 1974
MICHAEL RODAK, JR., CLERK

IN THE

Supreme Court of the United States

October Term, 1973

No. 73-1624

ANDREA DUMON, INC. and BERNARD MALITS,
Petitioners,

vs.

CLAIROL, INCORPORATED,
Respondent.

OPPOSITION TO PETITIONERS' WRIT FOR CERTIORARI

ALFRED T. LEE
WEIL, LEE & BERGIN
60 East 42nd Street
New York, New York 10017
Attorney for Respondent

TABLE OF CONTENTS

PAGE

Statement of the Case 1

REASONS FOR DENYING THE WRIT:

I—The prior rulings of this Court do not sustain the interpretation thereof upon which petitioners rely. Indeed those cases and other subsequently decided directly controvert Petitioiners' arguments 3

II—The adequacy of the proofs found sufficient by the Courts below is not for this Court to review. Neither is there any basis for review of the pleading rules of the Illinois Courts or the remedies they provide for fraud in commercial affairs 6

CONCLUSION 8

Table of Cases

Audio Fidelity, Inc. v. *High Fidelity Recordings, Inc.*, 283 F. 2d 551 (9th Cir. 1960) 6

Clase v. *Schultz*, 348 Ill. App. 595, 109 N.E. 2d 636 (1953) 7

Compco Corp. v. *Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964) 3

Fleischmann Distilling Corp. v. *Maier Brewing Co.*, 314 F. 2d 149 (9th Cir. 1963) 6

Goldstein v. *California*, 412 U.S. 546 (1973) 5

Hall v. *Cole*, 412 U.S. 1 (1973) 7

Kewanee Oil Co. v. *Bicron Corp.*, U.S. .. 5

Mills v. *Electric Auto-Lite Co.*, 396 U.S. 375 (1970) 7

PAGE

New England Awl Co. v. *Marlborough Awl Co.*, 46 N.E. 386, 387 (1897) 6

Sears Roebuck and Co. v. *Stiffel Co.*, 376 U.S. 225 (1964) 3

United Drug Co. v. *Theodore Rectanus Co.*, 248 U.S. 90 (1918) 4

Miscellaneous

Callman, The Laws of Unfair Competition, Trademarks and Monopolies, 3rd Ed. (1967) 5

Developments in the Law—Competitive Torts, 77 Harv. L. Rev. 888, 911-918 (1964) 6

Ill. Rev. Stat. 1967, ch. 110, Sec. 33 7

Lanham Trademark Act of 1946, 15 USC 1051 *et seq.* 4

Nims, Trademarks and Unfair Competition, 4th Ed. 5

Patent Law, 35 USC 171 3

State Trademark Registration Manual, United States Trademark Association, Rev. Ed. 1966 5

Trademark Act of 1905, 15 USC §§ 81-134 4

United States Constitution, Article I, § 8, cl. 8 4

IN THE

Supreme Court of the United States

October Term, 1973

No. 73-1624

ANDREA DUMON, INC. and BERNARD MALITS,

Petitioners,

VS.

CLAIROL, INCORPORATED,

Respondent.

OPPOSITION TO PETITIONERS' WRIT FOR CERTIORARI

Statement of the Case

With the exceptions noted below, Respondent will accept Petitioners' statement of the case for purposes of the within Petition.

1. As stated by Petitioners, they sold only $175 of their product in the offending trade dress, having discontinued the sale thereof soon after the suit was filed (apparently to avoid substantial liability for damages and an accounting of profits should they have continued those practices *pendente lite*). However, they gave notice of their intention to resume use of that trade dress unless Respondent procured an injunction, thus forcing the latter to the expense of a trial which resulted in a judgment that, in part, requires Petitioners to reimburse Respondent for a portion of such expense.

2. The evidence of "secondary meaning" was based upon more than an inference drawn from proof of intentional copying by Petitioners of Respondent's trade dress. There was also evidence of the considerable effort to which Respondent went in designing a unique and appealing package appearance; the distinctiveness of that appearance in contrast to the packaging of others, and the substantial exposure to the public of Respondent's product through its extensive display and sale.

3. Respondent did not contend for the exclusive right to the use of two horizontal bars and the color gold. It sought, and obtained, a judgment to preclude Petitioners' use of a colorable imitation of Respondent's trade dress, not an injunction directed to specific features such as bars and colors (Petitioner's Appendix, p. 12a). Petitioners opted to change their trade dress by removing the two bars and printing all of the graphics in black, to which Respondent had no objection. Petitioners could have made a myriad of other changes—while retaining the two bars and the color gold—which would avoid confusing similarity between their package's appearance and Respondent's.

4. There was testimony that, in some stores, consumers asked for Respondent's product by using the name "Clairol". However, there was also testimony that in other stores—including those owned by the individual petitioners—the products were displayed for self selection where trade dress would serve as the means of identification.

5. Petitioners "original label sketch" did not merely show "similarities" to Respondent's trade dress. It clearly was an overlay of the latter, with the handwritten word "Clairol" as a direction to the commercial artist concerning what he was to copy.

REASONS FOR DENYING THE WRIT

I.

The prior rulings of this Court do not sustain the interpretation thereof upon which Petitioners rely. Indeed those cases and other subsequently decided directly controvert Petitioners' arguments.

The essential thrust of the Petitioners' position herein is that the decision of the Illinois State Court below conflicts with this Court's rulings in *Sears, Roebuck and Co.* v. *Stiffel Co.*, 376 U.S. 225 (1964) and *Compco Corp.* v. *Day-Brite Lighting*, 376 U.S. 234 (1964). Petitioner's reliance upon those cases, however, rests upon a serious misreading of their facts.

Both involved an attempt to protect, under the doctrine of unfair competition, the physical configurations of products, such configurations being within the scope of the design patent laws, 35 USC 171. In fact, in each of those cases a design patent had been sought and obtained on the configuration—patents found invalid for lack of invention.

This case does not involve the configuration of a product but rather is concerned only with trade dress. Petitioners—new entrants in the field—were found to have deliberately copied the trade dress of the leading product in the category. They purposefully set out to offer their product garbed in the *tout ensemble* of their premier competitor.

In *Sears* and *Compco, supra,* this Court held that product configurations which fall within the scope of the design patent law may not be protected under state law concepts of unfair competition. The Court was careful, however, to distinguish between the copying of a product and the simulation of its distinctive package appearance. The State Court below specifically quoted the language of *Sears* wherein that distinction was drawn.

> "'(D)oubtless a State may, in appropriate circumstances, require that goods whether patented or unpatented, be labeled or that other precautionary steps be taken to prevent customers from being misled as to source, just as it may protect businesses in the use of their trademarks, labels, or *distinctive dress in the packaging of goods* so as to prevent others, by misleading purchasers as to the source of the goods. But because of the federal patent laws a State may not, when the article is unpatented and uncopyrighted, prohibit the copying of the article itself or award damages for such copying.' (Emphasis added)."
>
> Petitioner's Appendix, p. 23a.

The distinction is soundly based. Article I, § 8, cl. 8 of the Constitution vests Congress with the power to provide legal protection for the writings and discoveries of authors and inventors. *Sears* and *Compco* held that the Supremacy Clause precludes the states from protecting that which is within the scope of such federal power, but which fails to meet the standards established by Congress for protection thereunder.

Insofar as commercial identifications such as trademarks are concerned, however, Congressional action finds its authority in the Commerce Clause, that being the Constitutional predicate for the Lanham Trademark Act of 1946, 15 USC 1051 *et seq.*, *Fairway Foods* v. *Fairway Markets, Inc.*, 227 F. 2d 193, 196-7 (9th Cir. 1955) and its predecessor Trademark Act of 1905, 15 USC §§ 81-134, *United Drug Co.* v. *Theodore Rectanus Co.*, 248 U.S. 90 (1918).

It has not been responsibly suggested that enactment of the Lanham Act or its predecessor, 15 USC §§ 81-134, ousted the individual states from the prevention of

fraudulent commercial practices involving the deceptive use of trademarks, trade names and trade dress where such state action does not conflict with or override the federal scheme. Virtually every State in the Union has enacted legislation protecting such commercial indicia * and there is a vast body of state court decisions enforcing common law principles of business rectitude.** The side-by-side existence of both federal and state involvement in such protection for almost seventy years argues strongly for the propriety thereof, *Kewanee Oil Co.* v. *Bicron Corp.*,

U.S. , decided May 13, 1974.

The fatal flaw in Petitioners' argument is the absence of any contention that the State law relied upon below "clashes with the objectives of the federal patent laws" or any other federal statute, *Sears, Roebuck, supra* at 231.

Since *Sears, Roebuck* and *Compco*, this Court has carefully traced the bounds thereof insofar as they impact upon state action in related contexts. In *Goldstein* v. *California*, 412 U.S. 546 (1973) it was held that despite the refusal by Congress to protect sound recordings (pre-1972) from unauthorized copying, the states are not barred from doing so. More recently, it was held that the federal patent laws do not prevent the states from protecting trade secrets, even those which could have been, but were not, protected by federal patent, *Kewanee Oil Co.* v. *Bicron Corp., supra.*

---

* See *State Trademark Registration Manual, United States Trademark Association*, Rev. Ed., 1966.

** See generally, *Nims, Trademarks and Unfair Competition*, 4th Ed. (1947) and *Callman, The Laws of Unfair Competition, Trademarks and Monopolies*, 3rd Ed. (1967).

II.

The adequacy of the proofs found sufficient by the Courts below is not for this Court to review. Neither is there any basis for review of the pleading rules of the Illinois Courts or the remedies they provide for fraud in commercial affairs.

A.

It surely is not an issue of constitutional dimension that the Courts below relied upon a rational—indeed, a compelling—inference in holding Respondent's trade dress to be worthy of protection. Where one deliberately sets out to imitate the trade dress of the leading product in the field, it may safely be assumed that he, himself, recognizes the commercial value of that which he simulates, *Audio Fidelity, Inc.* v. *High Fidelity Recordings, Inc.*, 283 F. 2d 551 (9th Cir. 1960); *Fleischmann Distilling Corp.* v. *Maier Brewing Co.*, 314 F. 2d 149 (9th Cir. 1963), *Note, Developments in the Law—Competitive Torts*, 77 Harv. L. Rev. 888, 911-918 (1964).

Moreover, the Courts below also relied upon the extensive use of Respondent's trade dress in holding it proctectible. As long ago as 1897, Justice Holmes thought an inference of legal protectibility to be a proper one from such evidence and sufficient to dispense with the necessity for other proofs to establish the point.

> "The report states that it did not appear whether or not any purchaser of awls had learned to recognize the plaintiff's awls by the appearance of the packages. This cannot mean more than that there was no direct testimony to that effect. But the fact that the plaintiff had used the combination since 1885, and largely since 1893, is enough to raise a presumption in its favor."
>
> *New England Awl Co.* v. *Marlborough Awl Co.*, 46 N.E. 386, 387 (1897).

B.

Petitioners make the rather novel argument that, inasmuch as the complaint did not explicitly forwarn them of the substantive law upon which it was based, they were deprived of due process.

Illinois rules of pleading do not differ greatly from those of the federal courts. Illinois requires only that sufficient facts be alleged from which it can be ascertained what law is involved, *Clase* v. *Schultz*, 348 Ill. App. 595, 109 N.E. 2d 636 (1953). In close parallel to Rule 8 of the Federal Rules of Civil Procedure which requires no more than a "short and plain statement of the claim", Illinois requires only "a plain and concise statement" of the claim, Ill. Rev. Stat. 1967, ch. 110, Sec. 33.

Pleadings are not a constitutionally mandatory vehicle for the citation of statutes and the recitation of legal theories. Other procedures are available to ascertain a plaintiff's substantive reliance.

In any event, no showing is attempted here or was made below that Petitioners were in any way prejudiced by that of which they now complain.

C.

In *Fleischmann Distilling Corp.* v. *Maier Brewing Co.*, 386 U.S. 714 (1967) this Court acknowledged the propriety of awarding attorney's fees to a prevailing plaintiff when allowed by statute. The antitrust laws, to take but one example from federal statutes, exemplify both the deterrant and remedial value of such awards. Indeed, in the face of *Fleischmann*, this Court has since approved awards of attorney's fees despite the lack of a specific statutory authorization, *Mills* v. *Electric Auto-Lite Co.*, 396 U.S. 375, 389-97 (1970) (§ 14a of the 1934 Securities Act); *Hall* v. *Cole*, 412 U.S. 1, 4-15 (1973) (§ 102 of the Labor-Management Reporting and Disclosure Act).

Regarding Petitioner's due process argument, it should be sufficient to say that the complaint in this action expressly requested that attorney's fees be awarded. Petitioners, therefore, were on notice of the liability they faced and which was authorized by the state statute which they were found to have violated.

CONCLUSION

The decision below was eminently correct in holding that Petitioners had engaged in unfair competition with Respondent. No question of a constitutional nature has been made to appear herein.

WHEREFORE, Respondent prays that this Court refuse to issue the Writ sought.

Respectfully submitted,

ALFRED T. LEE
WEIL, LEE & BERGIN
60 East 42nd Street
New York, New York 10017
Attorney for Respondent